

REMARKS

Applicants submit this Amendment in reply to the Office Action mailed July 29, 2005.

By this Amendment, Applicants cancel claims 26, 34, 42, and 46, without prejudice or disclaimer, amend claims 25, 33, 41, and 45, and add new claims 52-59 to further define the claimed invention. The originally-filed specification, claims, and drawings fully support the subject matter of amended claims 25, 33, 41, and 45 and new claims 52-59. No new matter has been introduced.

Before entry of this Amendment, claims 25-51 were pending in this application. After entry of this Amendment, claims 25, 27-33, 35-41, 43-45, and 47-59 are pending in this application. Claims 25, 33, 41, and 45 are the sole independent claims.

On pages 2-3 of the Office Action, claims 1-51 were rejected under the judicially created doctrine of double patenting over claims 1-10 of U.S. Patent No. 6,761,685 and claims 1-17 of U.S. Patent No. 6,179,776. Applicants assume the reference to 1-51 is a typographical error and that the Examiner meant to refer to only pending claims 25-51. (Applicants note the reference to claims 25-51 only in the disposition of claims section of the Summary of the Office Action on page 1). In any case, without agreeing that pending claims 25-51 are unpatentable in view of claims 1-10 of U.S. Patent No. 6,761,685 and claims 1-17 of U.S. Patent No. 6,179,776, solely in the interests of expediting the prosecution of this application, Applicants file a Terminal Disclaimer herewith. Accordingly, Applicants respectfully request withdrawal of the double patenting rejection.



On pages 3-6 of the Office Action, claims 25-51 were rejected under 35 U.S.C. § 102(b) or 102(e) as being anticipated by each of U.S. Patent No. 4,245,624 to Komiya ("Komiya"), U.S. Patent No. 5,607,435 to Sachdeva et al. ("Sachdeva"), and U.S. Patent No. 6,066,090 to Yoon ("Yoon"). Applicants respectfully traverse each of these rejections.

None of the cited references disclose or suggest the claimed invention. For example, independent claim 25 recites, among other aspects, "a flexible elongated sheath configured to surround an endoscope, the sheath having a flexible lumen extending within the sheath and adapted for positioning adjacent to a surrounded endoscope so as to permit the lumen to move longitudinally in relation to the surrounded endoscope and extend beyond a distal tip of the surrounded endoscope," and a "controller device residing substantially parallel to the walls extending beyond the distal tip of the endoscope when the distal end of the flexible lumen is deflected." Independent claims 33 and 41 recite similar aspects. In another example, independent claim 45 recites, among other aspects, "a sheath configured to surround an endoscope, the sheath having a tube extending within it and adapted for positioning adjacent to a surrounded endoscope, the tube having walls defining the contours of the tube and the tube being capable of moving longitudinally in relation to the surrounded endoscope and extending beyond a distal tip of the surrounded endoscope," and a "controller residing substantially parallel to the walls of the distal end of the tube extending beyond the distal tip of the surrounded endoscope when the distal end of the tube is deflected."

Page 4 of the Office Action asserts that tube section 1, observation optical system 2, guide tube 5, and wire 6 of Komiya respectively correspond to the flexible

elongate sheath or sheath, endoscope, flexible lumen or tube, and controller device or controller of the claimed invention. Even assuming *arguendo* that this is correct, Komiya does not disclose or suggest that wire 6 is substantially parallel to the walls of guide tube 5 extending beyond the distal tip of observation optical system 2 when guide tube 5 is in the alleged deflected state shown in Fig. 3. Indeed, Komiya teaches away from such a configuration. If wire 6 was substantially parallel to guide tube 5 in Fig. 3, then guide tube 5 would not be deflected (see Fig. 2) as guide tube 5 depends on the proximal movement of wire 6 into a non-parallel position for deflection. Accordingly, because Komiya does not disclose, and indeed teaches away from the claimed invention, Applicants respectfully request withdrawal of the Section 102(b) rejection based on Komiya.

Page 5 of the Office Action asserts that polymeric jacket 74, delivery tube 14, tubular section 42, and delivery tube 50 of Sachdeva (shown in the Fig. 9 embodiment) respectively correspond to the flexible elongate sheath or sheath, endoscope, flexible lumen or tube, and controller device or controller of the claimed invention. Even assuming *arguendo* that this is correct, Sachdeva does not disclose or suggest that delivery tube 50 is substantially parallel to the walls of tubular section 42 extending beyond the distal tip of delivery tube 14 when the distal end of tubular section 42 is deflected. For example, Sachdeva does not even disclose that delivery tube 50 extends beyond a distal end of delivery tube 14. Indeed, Sachdeva discloses “securing two or more delivery tubes 14, 50 and 72 *together* in a juxtaposed lengthwise relationship by any suitable means, such as a polymeric jacket 74,” and that “separate delivery tubes 14, 50 and 72 [are] *connected together*.” (Col. 9, lines 43-47; col. 10, lines 43-49;

emphasis added). Thus, Sachdeva, instead of suggesting that tubes 50 and 14 move relative to one another, discloses that the tubes are "secured" together. Thus, even if section 42 extended beyond tube 14 and deflected, nothing suggests that any portion of tube 50 would reside substantially parallel to the extended, deflected walls of section 42. Accordingly, because Sachdeva does not disclose the claimed invention, Applicants respectfully request withdrawal of the Section 102(b) rejection based on Sachdeva.

Page 6 of the Office Action asserts that two branch endoscope 42, first endoscope branch 44, second endoscope branch 46, and a pull wire allegedly disclosed in col. 6, lines 5-12 of Yoon respectively correspond to the flexible elongate sheath or sheath, endoscope, flexible lumen or tube, and controller device or controller of the claimed invention. Even assuming *arguendo* that this is correct, Yoon does not disclose or suggest that two branch endoscope 42 is configured to surround first endoscope branch 44, as set forth in the independent claims, as first endoscope branch 44 is fixedly connected to, and indeed is one of the two branches of, two branch endoscope 42. Similarly, second endoscope branch 46 does not extend within two branch endoscope 42, and the claims require that the flexible lumen or tube extend within the sheath. Moreover, Yoon does not disclose or suggest that second endoscope branch 46 moves longitudinally in relation to first endoscope branch 44 as, again, first endoscope branch 44 and second endoscope branch 46 are fixedly connected to, and indeed are the two branches of, two branch endoscope 42. Branches 44 and 46 are fixed longitudinally relative to one another by virtue of their connection at branching point 52. Accordingly, because Yoon does not disclose the claimed invention,

Applicants respectfully request withdrawal of the Section 102(b) rejection based on Yoon.

Claims 27-32, 35-40, 43-44, and 47-59 depend from one of independent claims 25, 33, 41, and 45, and are therefore allowable for at least the same reasons that each of the corresponding independent claims is allowable. In addition, at least some of the dependent claims recite unique combinations that are neither taught nor suggested by Komiya, Sachdeva, Yoon, or other cited art, and therefore are separately patentable.

In view of the foregoing remarks, Applicants submit that this claimed invention, as-amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry and consideration of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of pending claims 25, 27-33, 35-41, 43-45, and 47-59.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.


In discussing the specification and claims in this Amendment, it is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and/or shown in the drawings. Rather, Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Please grant any extensions of time required to enter this Amendment and
charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: October 20, 2005

By: 
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Attachments: Terminal Disclaimer (3 pages)